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09/801,489	03/07/2001	Lianli Ji	055-01	4749

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/801,489

Applicant(s)

Ji

Examiner

Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Apr 24, 2003

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 23-36 and 38-79 is/are pending in the application.

4a) Of the above, claim(s) 38-57 and 64 is/are withdrawn from consideration.

5) Claim(s) 23-36 is/are allowed.

6) Claim(s) 58-63 and 65-79 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4, 16, 18

6) Other:

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse in Paper No. 17 is acknowledged.

Please note that examiner's use of terminology of "Group I, Group IIa, and Group IIb" relates to three equally independent embodiments of the invention. The terminology IIa and IIb was only used so as to avoid confusion as to Group II in view of the second requirement.

The traversal is on the ground(s) that there are or were generic claims. This is not found persuasive because claims containing limitation of "pawl pivotally secured to said housing" were not generic to the different embodiments of the requirement.

Regardless however, where there are generic claims (claims drawn to the 'genus' but not specific to any 'sub-species') that are not yet allowed, an election of species for the reasons given in the previous Office Action is proper nonetheless. Argument that election based on the disclosure is improper is not persuasive. Presently, independent embodiments of the invention (i.e., not disclosed to be combination/ sub-combination or other 'relation' therebetween) are disclosed and claimed.

excerpt MPEP 806. "where inventions are independent (i.e., no disclosed relation therebetween), restriction to one thereof is ordinarily proper, MPEP 806.04-806.04(I)".

excerpt MPEP 806.04(e) "Species are usually but not always independent as disclosed since there is usually no disclosure of relationship therebetween, the fact that a genus for

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two different embodiments is capable of being conceived and defined, does not affect the independence of the embodiments, where the case under consideration contains no disclosure of any commonality of operation, function or effect”.

The election requirement does not place hardship on Applicant since generic claims will be examined and if found allowable, Applicant is permitted claims to consideration of claims drawn to other of the embodiments that are in dependent form from the allowed generic claim(s).

Applicant should note that if any claims are added by amendment, Applicant’s response must indicate which embodiment(s) of the invention, the claims read on.

The requirement is still deemed proper and is therefore made FINAL.

2. Consequently claims, 23-36, 58-62, 64-79 are elected and examined herein below. Claims 38-57 are withdrawn from further consideration.

Claim Objections

3. Claims 75 and 79 are objected to because of the following informalities:

- a. Claim 75 - recitation of “for” seems to be a typo and should be deleted.
- b. Claim 79 - recitation of “an” should be replaced with --and-- to correct typo.

Appropriate correction is required.

- c. Claim 79, recitations of “said linking means”, “said linking means activator member”, “said keeper-engaging connecting member”.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 59-63 and 65-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As regards claim 59 and 60, terminology of “linking means” (claim 59 and 60) and “interlocking means” (claim 60) is not used in the specification with respect to the elected embodiment of the invention whereby it is not clear which structure(s) should or should not be included. It is assumed that Applicant intends the limitation to cover any structure of any of the embodiments that performs the broadly-recited function but clarification is required and/or amendment of the specification to clearly indicate which structure(s) should be covered by the limitation. See MPEP 2181-2185.

Similarly as regards claim 79, terminology of “means connected with said housing for connecting said activator member to said keeper-engaging member” is not used in the specification with respect to the elected embodiment of the invention whereby it is not clear which structure(s) should or should not be included. It is assumed that Applicant intends the limitation to cover any structure of any of the embodiments that performs the broadly-recited function but clarification is required and/or amendment of the specification to clearly indicate which

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structure(s) should be covered by the limitation. See MPEP 2181-2185. It is not clear if later recitation of “said linking means” is in reference to the previously recited “means,..., for connecting”.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 58-62, 64-67, 71, and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,070,923 to Tanimoto in view of U.S. Pat. No. 5,732,988 to Mizuki.

As regards claims 58-60, Tanimoto '923 discloses a “handle” - 5 and “pendulum” - 9 but does not illustrate the car door, “pawl” (latch bolt) or “pawl-retaining arm” with which the device is intended to be used. Mizuki '988 teaches a conventional motor vehicle door (2) and door latch (6) having a “pawl” - 10, “pawl-retaining arm” 11, and “means for pivotally securing said housing and said pawl -retaining arm” - the pivot pin illustrated in Fig 3. One of ordinary skill in the art would have found it obvious at the time of the invention to combine the above elements of

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Tanimoto '923 with the prior art door and door latch for the purpose of assembling the invention of Tanimoto '923 into its intended environment.

Further regarding claims 58 and 60, the combination of part 2 of Tanimoto '923 and the door shell (2) and latch shell of Mizuki '988 as relied upon, read on limitation of "housing". As regards limitation of "means connected to said pawl for biasing its position", one of ordinary skill in the art would recognize spring biasing part 10 to be inherent to teaching of the reference where the examiner takes Official Notice that the biasing structure is common to virtually all modern vehicle latch structure.

As regards claim 59, as best understood, part 11 reads on limitation of "interlocking means" as being nearly identical to the structure Applicant has disclosed for performing the recited function and is considered equivalent..

As regards claim 60, as best understood, part 9 reads on "linking means" as nearly identical structure to that disclosed for performing the recited function and is considered to be equivalent structure.

As regards claims 61, 62, the linking means of Tanimoto '923, as relied upon is inherently capable of the recited function when the door is tilted between vertical and horizontal positions.

As regards claim 67, the "pawl" of Mizuki '988, as relied upon, has a "pair of forward arms" that engage part 9 (as shown in Fig 3) and a "rearward projecting arm" - 21.

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As regards claim 79, Tanimoto '923 teaches Applicant's claim limitations including a "housing" -2 , a "keeper engaging member" - one of ordinary skill in the art would recognize a conventional vehicle latch bolt is inherent to teaching of the reference. Regardless, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above elements of Tanimoto '923 with the prior art door and door latch for the purpose of assembling the invention of Tanimoto '923 into its intended environment of use. Mizuki '988, as relied upon, teaches a "keeper engaging member" - 10.

Tanimoto '923, as relied upon, teaches additional claimed elements including : an "activator member connected with said housing" - 5, "means for connecting" - including 9,11,12 as shown in Fig 9 for example, a "gravity sensitive link" - 9, "first,..., second position" as shown in broken and solid lines in Fig 9.

As best understood, the "linking means" (9) of the reference is nearly identical and considered equivalent for the purpose of performing the broadly recited function accompanying the 'means' limitation.

Functional description of "when said housing is moved" does not define any structure of the invention that might be relied upon to patentably define from the prior art. See MPEP 2114. It appears to be related to *intended use* of the claimed invention. Regardless, one of ordinary skill in the art would recognize that part 9 of the reference is free to rotate (due to the force of gravity) between the positions illustrated in Fig 9 should the housing be tilted (as opposed to pivoting because of inertial forces from a crash). It has been held that a recitation with respect to the

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manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). It's noted that this is a *product* claim, the *product* being defined by the structure claimed and not a *process of using* claim. See MPEP 2173.05(p) sections I,II.

Allowable Subject Matter

8. Claims 23-36 are allowed.

9. Claims 68-70 and 72-78 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Pat. No. 2,864,641 to Leslie.
- b. U.S. Pat. No. 3,359,767 to Arlauskas.
- c. U.S. Pat. No. 4,536,021 to Mochida.
- d. U.S. Pat. No. 5,769,471 to Suzuki.

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11. Submission of any response by facsimile transmission is encouraged. Group 3677's relevant facsimile numbers are :

- 703-872-9326, for formal communications for entry **before Final** action: or
- 703-872-9327, for formal communications for entry **after Final** action.

Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly within our examining group and will eliminate Post Office processing and delivery time and will bypass the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a Deposit Account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) ____ - ____) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the

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processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is (703) 308 - 0494. The examiner can normally be reached on M - Th from 730 am to 600 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann, can be reached on (703) 306-4115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

- Technology Center 3600 Customer Service is available at 703-308-1113.
- General Customer Service numbers are at 800-786-9199 or 703-308-9000.

GWE

May 8, 2003



GARY ESTREMSKY
PRIMARY EXAMINER